

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of December 12, 2007 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

### **Claims Rejections – 35 USC § 103**

In the Office Action, Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2002/0019667 to Hicks, III (hereinafter Hicks), in view of U.S. Published Patent Application 2002/0006797 to Virtanen (hereinafter Virtanen).

Although Applicants respectfully disagree with the rejections under 35 U.S.C. § 103(a), Applicants respectfully submit that the rejections are moot because Hicks is not available as prior art reference as discussed below.

### **Applicants' Invention Predates Hicks**

Applicants believe that any rejections are moot because Applicants' invention predates the June 6, 2003 effective date of Hicks.

The inventors of the present invention conceived their invention at least as early as March 17, 2003 and actively pursued its reduction to practice from a date prior to the earliest effective date of Hicks. In support of their assertions of conception, diligence, and constructive reduction to practice, Applicants submit the Declarations attached hereto in accordance with 37 CFR § 1.131 along with other supporting evidence of inventors' diligence in pursuing the present Application. The Declarations provide the sworn testimony of the inventors affirming their conception and continuing diligence from a time prior to the earliest effective date of Hicks to the filing of the instant Application on

December 15, 2003. Please note that the Declaration by Inventor Victor Moore is unsigned. A Declaration with his signature will be submitted as soon as such a signed copy is obtained.

Along with these Declarations, Applicants also submit herewith a copy of a confidential invention disclosure, No. BOC8-2003-0050, titled "Using a Cellular control channel to roam between 802.11 networks," authored by Inventor Neil Katz (hereinafter Disclosure). The Disclosure was submitted on March 17, 2003 to a Patent Attorney/Intellectual Property (IP) Professional employed by the assignee of the present invention, International Business Machines Corporation (IBM).

The Disclosure explicitly describes the present invention. The written description provided in the Disclosure is clear evidence of the inventors' conception of the claimed subject matter at least as early as March 17, 2003.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Patent Attorney/IP Professional.

Applicants exercised due diligence from prior to the earliest effective date of Hicks to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants, from at least the earliest effective date of Hicks, through the filing of the Application on December 15, 2003, worked diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house Patent Attorneys/IP professionals during an internal review of the invention, including assessing the invention in the context of related literature. Subsequently,

Applicants worked with Patent Attorneys retained by IBM (outside counsel) to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures and Applicants' sworn testimony in the Declarations, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

The following documentary evidence is submitted herewith in supporting Applicants' claims of due diligence:

- Exhibit A is an email letter, dated September 25, 2003, from Inventor Tom Creamer to IBM in-house counsel with comments regarding search results.
- Exhibit B is a letter from an IBM Patent Attorney requesting outside counsel prepare the Application, dated September 25, 2003.
- Exhibit C is a letter from outside counsel confirming receipt of the instructions, dated October 2, 2003.
- Exhibit D is an email letter from outside counsel requesting review and approval of the Application drafted by outside counsel, dated November 29, 2003.
- Exhibit E is an email letter from Inventor Neil Katz, approving the draft Application, dated November 30, 2003.

- Exhibit F is an email letter, dated December 1, 2003, from outside counsel requesting review and final approval of the Application, together with Declaration and Power of Attorney and Assignment for the inventors to sign.
- Exhibit G is a copy of the Declaration and Power of Attorney signed by the inventors and filed with the Application on December 15, 2003, evidencing the inventors' approval of the application.

Applicants respectfully submit that it was reasonable for them and the Assignee of their invention, IBM, to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence. Applicants and outside counsel operated under the constraints of other work obligations while preparing the Application. As noted in MPEP § 2138.06, inventors and their patent attorneys are never required to drop all other work to deal with an issue in a patent application. Applicants therefore submit that Applicants and their Patent Attorneys diligently pursued completion and filing of the present application without any unreasonable delays.

Accordingly, Applicants respectfully submit that Applicants' Declarations, coupled with the documentary evidence of specific activity on specific dates, clearly evidences Applicants' prior conception and diligence in pursuing an actual and constructive reduction to practice from a time prior to the earliest effective date of Hicks. Applicants therefore respectfully request withdrawal of all rejections in connection with Hicks.

### CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the

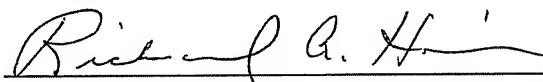
Appln No. 10/736,137  
Amendment dated February 12, 2008  
Reply to Office Action of December 12, 2007  
Docket No. BOC9-2003-0093 (464)

Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

Date: February 12, 2008

A handwritten signature in dark ink, appearing to read "Richard A. Hinson", is written over a horizontal line.

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